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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/456,288	12/08/1999	STEVEN BENJAMIN DAVIS	2237.2	6243

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EXAMINER	
MOISE, EMMANUEL LIONEL	
ART UNIT	**PAPER NUMBER**
2136	3

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/456,288	DAVIS, STEVEN BENJAMIN	
	Examiner	Art Unit	
	Emmanuel L. Moise	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 July 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-54* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on *08 December 1999* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-54 are presented for examination.

Claim Objections

2. Claims 4, 6, and 8 are objected to because of the following informalities:

In claim 4, in line 7, "provide" should apparently read as –provider--.

In claims 6 and 8, in lines 3-4, and 1, respectively, "said a" should apparently be replaced with –said--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Furukawa et al. (U.S. Patent No. 6,618,366, hereinafter "Furukawa").

As per claim 1, Furukawa teaches the claimed method for a provider to verify a client's secret identifier, comprising the steps of: the client scrambles his/her predetermined secret identifier in a random way with random data (column 79, lines 28-38); the scrambled data is transmitted to the provider (column 79, lines 64-67); and the provider determines whether the client's secret identifier is present in the received scrambled data (column 80, lines 49-54).

As per claim 2, Furukawa teaches a method wherein the provider rejects a transaction if the random data in the received scrambled data is substantially the same (or is different from) as random data received in a previous transaction corresponding to said client (column 81, lines 1-9).

As per claim 3, Furukawa teaches the claimed method for a provider to verify a client's secret identifier received in scrambled data which includes the secret identifier scrambled with random data, comprising the steps of: determining whether the client's secret identifier is present in the received scrambled data (column 80, lines 49-54); comparing the random data in the received scrambled data with previously received random data corresponding to said client (column 81, lines 1-9); and authorizing a transaction if the random data in the received scrambled data is substantially different from said previously received random data (column 81, lines 1-9).

As per claim 4, Furukawa teaches the claimed apparatus for a provider to verify a client's secret identifier, comprising: means for the client to scramble his/her predetermined secret identifier in a random way with random data (column 79, lines 28-38); a transmitter which

transmits the scrambled data to the provider (column 79, lines 64-67); and a provide processor which is used to determine whether the client's secret identifier is present in the received scrambled data (column 80, lines 49-54).

As per claim 5, Furukawa teaches an apparatus wherein the provider processor rejects a transaction if the random data in the received scrambled data is substantially the same (or is different from) as random data received in a previous transaction corresponding to said client (column 81, lines 1-9).

As per claim 6, Furukawa teaches the claimed process for a consumer to submit secure verification information, comprising the steps of: obtaining a secret identifier from a provider, said secret identifier being unique to said consumer (column 79, lines 28-38); randomly scrambling the consumer's secret identifier with a plurality of randomly selected alphanumeric characters (column 79, lines 28-38); and submitting the combined randomly scrambled secret identifier and plurality of randomly selected alphanumeric characters to the provider (column 79, lines 64-67).

As per claims 7-13, Furukawa teaches that the submitting step and/or the randomly scrambling step are performed on the Internet, a computer network, a building security system, a telephone system, a credit or debit card verification system, an ATM system, and/or a phone card system (column 1, lines 7-17).

As per claim 14, Furukawa teaches that the consumer manually performs said randomly scrambling step (column 79, lines 64-67).

As per claim 15, Furukawa teaches that the provider rejects the submitted randomly scrambled identifier if the randomly scrambled identifier is substantially identical (or is different

from) to a randomly scrambled identifier previously submitted to the provider (column 81, lines 1-9).

As per claim 16, Furukawa teaches that the randomly scrambling step includes the step of changing an order of alphanumeric characters in the secret identifier (column 79, lines 42-45).

As per claim 17, Furukawa teaches the claimed method of transacting a charge card purchase, comprising the steps of: providing a user with a transaction form (this step is inherent in Furukawa); receiving from the user a credit card number and a super identifier ... (column 79, lines 28-48); comparing the received super identifier with a plurality of previously received super identifiers (column 80, line 60 – column 81, line 1); and accepting the credit card transaction if the received super identifier is not substantially identical to previously received super identifiers (column 81, lines 1-9).

As per claims 18-21, Furukawa teaches that the charge card purchase comprises a credit card purchase, a debit card purchase, a phone card purchase, a lottery ticket purchase (column 1, lines 7-20).

As per claim 22, Furukawa teaches that the secret identifier comprises a PIN (column 79, lines 28-30).

As per claim 23, Furukawa teaches that the randomly chosen alphanumeric characters are chosen by the user (column 79, lines 28-44).

As per claim 24, Furukawa teaches that the number of randomly chosen alphanumeric characters are the same as the number of characters in the secret identifier (column 79, lines 32-38).

As per claims 25-27, Furukawa teaches that the method is performed at a point of sale, at a provider server, or over the Internet (column 1, lines 1-7).

As per claim 28, Furukawa teaches that the secret identifier is scrambled by the user using the plurality of alphanumeric characters (column 79, lines 28-44).

As per claims 29 and 54, Furukawa teaches a method or an apparatus for carrying out a secure financial transaction, comprising: receiving from a user (i) a request for a transaction and (ii) a super PIN which comprises a PIN scrambled with a plurality of alphanumeric characters randomly chosen by a user (column 79, lines 28-38); and rejecting the request if the received super PIN is substantially similar to a previously received super PIN (column 80, line 60 – column 81, line 4).

As per claims 30 and 31, Furukawa teaches that the rejection criteria is dependent on the Super PIN including all of the alphanumeric characters that comprise the user's secret identifier, or substantially all of the plurality of randomly selected alphanumeric characters from a previous transaction (column 80, line 51 – column 81, line 11).

As per claims 32 and 33, Furukawa teaches that the previously used plurality of randomly selected alphanumeric characters are stored and that the rejection of the Super PIN validation triggers a supplementary validation activity (column 81, lines 1-11).

As per claim 34, Furukawa teaches the claimed apparatus for a consumer to submit verification information including a secret identifier obtained from a provider, said secret identifier being unique to said consumer (column 79, lines 64-65), said apparatus comprising: means for randomly scrambling the consumer's secret identifier with a plurality of alphanumeric

characters (column 79, lines 28-38); and means for submitting the randomly scrambled secret identifier to the provider (column 79, lines 64-67).

As per claim 35-40, Furukawa teaches that the submitting step and/or the randomly scrambling step are performed on the Internet, a computer network, a building security system, a telephone system, a credit verification system, and/or an ATM system (column 1, lines 7-17).

As per claims 41and 42, Furukawa teaches that the random scrambling is performed manually and/or by an automated process (column 79, lines 28-38).

As per claim 43, Furukawa teaches that the automated process creates the Super PIN on behalf of the user (column 79, lines 28-38).

As per claim 44, Furukawa teaches that the provider server rejects the submitted randomly scrambled identifier if the randomly scrambled identifier is substantially identical (or is different from) to a randomly scrambled identifier previously submitted to the provider (column 81, lines 1-9).

As per claim 45, Furukawa teaches that the means for randomly scrambling includes means for changing an order of alphanumeric characters in the secret identifier (column 79, lines 42-45).

As per claim 46, Furukawa teaches the claimed apparatus for transacting a charge card purchase, comprising: means receiving from the user a credit card number and a super identifier ... (column 79, lines 28-48); means for comparing the received super identifier with a plurality of previously received super identifiers (column 80, line 60 – column 81, line 1); and means for accepting the credit card transaction if the received super identifier is not substantially identical to previously received super identifiers (column 81, lines 1-9).

As per claim 47, Furukawa teaches that the secret identifier comprises a PIN (column 79, lines 28-30).

As per claim 48, Furukawa teaches that the randomly chosen alphanumeric characters are chosen by the user (column 79, lines 28-44).

As per claim 49, Furukawa teaches that the number of randomly chosen alphanumeric characters are the same as the number of characters in the secret identifier (column 79, lines 32-38).

As per claims 50-52, Furukawa teaches that the means for receiving are disposed at a point of sale, at a provider server, or over the Internet (column 1, lines 1-7).

As per claim 53, Furukawa teaches that the secret identifier is scrambled by the user using the plurality of alphanumeric characters (column 79, lines 28-44).

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,724,423 (Khello)

5,737,422 (Billings)

5,940,511 (Wilfong)

6,185,316 (Buffam)

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel L. Moise whose telephone number is (703)305-9763. The examiner can normally be reached on M-W and F-Sat (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on (703)305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Emmanuel L. Moise
Primary Examiner
Art Unit 2136

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